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EXAMINER	
VOLLANO, JEAN F	

ART UNIT	PAPER NUMBER
1621	

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/582,950	PETTIT ET AL.	
	Examiner	Art Unit	
	Jean F. Vollano	1621	

-- The MAILING DATE of this c mmunication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *11-40* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The examiner notes that the previously written office action was directed to claims that were elected by original presentation. However applicant has stated that the office inadvertently placed the continuing application in as an RCE when in fact a CPA was requested. The examiner reviewed the case and applicant had indeed filed a CPA and could change inventions. The examiner has reviewed the claims and found that claim 11 was added on 4/30/2002 which was drawn to a compound claim. Mr Mybeck did not submit a proper amendment and a series of non responsive letters were sent out. This went on for almost a year. The amendments still were not proper and finally in an attempt to hasten prosecution, the examiner discussed the issue with Mr Dixon and decided to act on what was part of the application that had been submitted properly. It was a second action and was made final. The power of attorney then changed a few days after the final office action was sent out. This was 1/8/2003. Then a CPA was filed and new claims were presented. The office entered the amendment as an RCE and the examiner acted as if it were an RCE. The groups were made but not strictly defined and clarified since they were going to be removed from consideration by original presentation since an RCE cannot change inventions. However Applicant's attorney Ms Rosenfield called the examiner to clarify. And indeed a CPA was submitted and the examiner had examined the previously elected claims as should be done in an RCE. The newly submitted claims are extensive changes from the original claims. Since they were not present originally, the examiner finds that there should be an officially written lack of unity on the new claims and as such this response will be a lack of unity to clarify the groups and the reasons why they lack unity. Then applicant may elect a group for examination. This is the only way to really clarify the record of the newly added claims. It is

claims are very much broader than the original claims and are drawn to nucleosides, nucleotides, aminosugars etc which were not claimed originally.

2. The examiner will make some observations on some of the claims to help hasten the prosecution of this application. First please note that claim 15 does not further limit since the choices are all the possible tetrahalomethanes and claim 11 already states that the solvent is a tetrahalomethane which includes only all the choices given.

The examiner also is having trouble finding the limitations of all nucleoside, nucleotides, alkaloids, amino sugars, amino nitrile and nitrogen containing antibiotics in the specification. Please point out where there is support for these. Also the term heteroarylene and heterocyclyl do not seem to be given in the broadest terms. Please show support for all heterocycles. It is unclear what the difference is between heteroarylene and heterocyclyl. Is one aromatic and the other aromatic and not aromatic? This nomenclature is confusing. Also the examiner notes that there seems to be an appreciable amount of new matter added to what is being prepared.

3. Upon reviewing the claims for examination the examiner notes that there is a requirement of a tertiary amine and an acylation catalyst. In claim 16 the tertiary amine is given. However in claim 17 the acylation catalyts is a teriary amine according to applicant's nomenclature of claim 16 wherein pyridine is a tertiary amine. In claim 17 the catalyst is dimethylamino pyridine which is also a tertiary amine. The examiner tried to find the term acylation catalyst in the specification to see what it was defined as and was unsuccessful so please show support from the specification for the term and the definition of the metes and bounds of this term. For restriction purposes the

examiner will use the amines as both being present and as an acylation catalyst. Also DBU is being used as an amine. The examiner does not know the abbreviation. Please show where in the specification this is defined and to avoid confusion it would be helpful if applicant placed the full name of what is being claimed in the claim.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 11-16, 18-22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is $O^- Q^+$ wherein Q is an alkali metal, alkali earth metal, transition metal which is a salt of the trans isomer , or one OR1 or OR 2 is the O alkali metal, alkali earth metal , transition metal and the other is OH and wherein the catalyst and/or amine is N,Ndiisopropyl ethylamine, triethyl amine or another alkyl amine and the solvent is a non halogenated solvent.

Group II , claim(s) 11-22 (in part) wherein X is trans and at least one of OR1 or OR2 is O^-Q^+, is an alkali metal, alkali earth metal, transition metal which is a salt of the trans isomer and the other OR1 or OR2 is a hydroxide or the alkali metal, alkali earth metal, transition metal salt, wherein the catalyst and/or amine is an pyridine and the solvent is a non halogenated solvent.

Group III, claim(s) 11-16, 18-22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is $O^- Q^+$ wherein Q is an alkali metal, alkali earth metal, transition metal which is a salt of the trans isomer , or one OR1 or OR 2 is the O alkali metal, alkali earth metal , transition metal and the other is OH and wherein the catalyst and/or amine is morpholine and the solvent is a non halogenated solvent.

Group IV, claim(s) 11-16, 18-22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is $O^- Q^+$ wherein Q is an alkali metal, alkali earth

metal, transition metal which is a salt of the trans isomer , or one OR1 or OR 2 is the O alkali metal, alkali earth metal , transition metal and the other is OH and wherein the catalyst and/or amine is DBU and the solvent is a non halogenated solvent.

Group V, claim(s) 11-16, 18-22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is $O^- Q^+$ wherein Q is an alkali metal, alkali earth metal, transition metal which is a salt of the trans isomer , or one OR1 or OR 2 is the O alkali metal, alkali earth metal , transition metal and the other is OH which process is not found above. If this group is chosen then further restriction may be required.

Groups VI-X are the same as Groups I-V except that the solvent is a halogenated solvent and thus claim 20 is not found in this group. The rest of the claims are the same as above.

Group XI, claim(s) 11-12, 14-16, 18-20, 22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is Q wherein Q is a heteroarylene or heterocyclyl which is a trans isomer , or one OR1 or OR 2 is the O is a heteroarylene or heterocyclyl and the other is OH and wherein the catalyst and/or amine is N,Ndiisopropyl ethylamine, triethyl amine or another alkyl amine and the solvent is a non halogenated solvent.

Group XII , claim(s) 11-12, 14-20, 22 (in part) wherein X is trans and at least one of R1 or R2 is Q, is heteroarylene or heterocyclyl which is a trans isomer and the other OR1 or OR2 is a hydroxide or heteroarylene or heterocyclyl, wherein the catalyst and/or amine is an pyridine and the solvent is a non halogenated solvent.

Group XIII, claim(s) 11-12, 14-16, 18-20, 22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is Q wherein Q is a heteroarylene or heterocyclyl which is a trans isomer, or one OR1 or OR 2 is the O a heteroarylene or heterocyclyl and the other is OH and wherein the catalyst and/or amine is morpholine and the solvent is a non halogenated solvent.

Group XIV, claim(s) 11-12 , 14-16, 18-20, 22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is Q wherein Q a heteroarylene or heterocyclyl which is a salt of the trans isomer , or one OR1 or OR 2 is the O a heteroarylene or heterocyclyl, and the other is OH and wherein the catalyst and/or amine is DBU and the solvent is a non halogenated solvent.

Group XV, claim(s) 11-12, 14-16, 18-20, 22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is Q wherein Q is a heteroarylene or heterocyclyl, or one OR1 or OR 2 is the O a heteroarylene or heterocyclyl and the other is OH which process is not found above. If this group is chosen then further restriction may be required.

Groups XVI-XX are the same as Groups XI-XV except that the solvent is a halogenated solvent and thus claim 20 is not found in this group. The rest of the claims are the same as above.

Group XXI, claim(s) 11-12, 14-16, 18-20, 22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is Q wherein Q is nucleoside or a nucleotide which is a trans isomer , or one OR1 or OR 2 is the O nucleoside or a nucleotide and the other is OH and wherein the catalyst and/or amine is N,Ndiisopropyl ethylamine, triethyl amine or another alkyl amine and the solvent is a non halogenated solvent.

Group XXII , claim(s) 11-12, 14-20, 22 (in part) wherein X is trans and at least one of R1 or R2 is Q, is nucleoside or a nucleotide and the other OR1 or OR2 is a hydroxide or a nucleoside or a nucleotide, wherein the catalyst and/or amine is an pyridine and the solvent is a non halogenated solvent.

Group XXIII, claim(s) 11-12, 14-16, 18-20, 22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is Q wherein Q is a nucleoside or a nucleotide, or one OR1 or OR 2 is the O nucleoside or a nucleotide and the other is OH and wherein the catalyst and/or amine is morpholine and the solvent is a non halogenated solvent.

Group XXIV, claim(s) 11-12 , 14-16, 18-20, 22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is Q wherein Q nucleoside or a nucleotide which is a trans isomer , or one OR1 or OR 2 is the O nucleoside or a nucleotide, and the other is OH and wherein the catalyst and/or amine is DBU and the solvent is a non halogenated solvent.

Group XXV, claim(s) 11-12, 14-16, 18-20, 22 (in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is Q wherein Q is a nucleoside or a nucleotide, or one OR1 or OR 2 is the O nucleoside or a nucleotide and the other is OH which process is not found above. If this group is chosen then further restriction may be required.

Groups XXVI-XXX are the same as Groups XXI-XXV except that the solvent is a halogenated solvent and thus claim 20 is not found in this group. The rest of the claims are the same as above.

Groups XXXI-XL are the same as XXI-XXX except that the Q is an alkaloid (The claim numbers are the same.

Groups XLI-L are the same as XXI-XXX except that the Q is and aminosugar (the claim numbers are the same.)

Groups LI- LX are the same as XXI-XXX except that the Q is and aminonitrile (the claim numbers are the same.)

Groups LXI- LXX are the same as XXI-XXX except that the Q is and a nitrogen containing antibiotic(the claim numbers are the same.)

Groups LXXI to CXL are the same as Groups I-LXX except that the isomer is cis and not trans and this Group includes additional claim 30.

Group CXLI claim(s) 23- 28(in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is $O^- Q^+$ wherein Q is an alkali metal, alkali earth metal, transition metal which is a salt of the trans isomer , or one OR1 or OR 2 is the O alkali metal, alkali earth metal , transition metal and the other is OH and wherein the oxidizing agent is a mCPBA (please define and show the definition in the specification) and the solvent is a non halogenated solvent.

Group CLXII , claim(s) 23-28 (in part) wherein X is trans and at least one of OR1 or OR2 is $O^- Q^+$, is an alkali metal, alkali earth metal, transition metal which is a salt of the trans isomer and the other OR1 or OR2 is a hydroxide or the alkali metal , alkali earth metal , transition metal salt, wherein the oxidizing agent is hydrogen peroxide and the solvent is a non halogenated solvent.

Group CXLIII, claim(s) 23-28(in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is $O^- Q^+$ wherein Q is an alkali metal, alkali earth metal, transition metal which is a salt of the trans isomer , or one OR1 or OR 2 is the O alkali metal, alkali earth metal , transition metal and the other is OH and wherein the oxidizing agent is t-butylhydroperoxide and the solvent is a non halogenated solvent.

Group CXLIV, claim(s) 23-28(in part), drawn to a process for preparing a compound of formula III wherein X is trans and R1 or R2 is $O^- Q^+$ wherein Q is an alkali metal, alkali earth metal, transition metal which is a salt of the trans isomer , or one OR1 or OR 2 is the O alkali metal, alkali earth metal , transition metal and the other is OH and wherein the oxidizing agent is peroxyacids and the solvent is a non halogenated solvent.

Groups CXLV-CXLVIII are the same as Groups CXLI-CXLIV except that the solvent is a halogenated solvent. The claims are the same as above.

Group CXLIX-CLII are the same as Groups CXLI-CXLIV except that the solvent is a mixture of halogenated and unhalogenated solvents. The claims are the same except that claim 29 is added to this group.

Groups CLIII-CLXIV are the same as Groups CXLI-CXLII except that the compound has as a Q which is at least one heteroarylene or heterocyclyl and the other Q can be the same or OH. The claim numbers are the same for each group as those in CXLI-CXLII.

Groups CLXV-CLXXVI are the same as Groups CXLI-CXLII except that the compound has as a Q at least one is a nucleoside or nucleotide and the other Q can be the same or OH. The claim numbers are the same for each group as those in CXLI-CXLII.

Groups CLXXVII-CLXXXVIII are the same as Groups CXLI-CXLII except that the compound has as a Q at least one of which is an alkaloid and the other Q can be the same or OH. The claim numbers are the same for each group as those in CXLI-CXLII.

Groups CLXXIX-CC are the same as Groups CXLI-CXLII except that the compound has as a Q wherein at least one is a amino sugar and the other Q can be the same or OH. The claim numbers are the same for each group as those in CXLI-CXLII.

Groups CC-CCXII are the same as Groups CXLI-CXLII except that the compound has as a Q at least one is a nitrogen containing antibiotic and the other Q can be the same or OH. The claim numbers are the same for each group as those in CXLI-CXLII.

Groups CCXIII-CCXCIV are the same as Groups CXLI-CCXII except that the compound is a cis isomer.

Group CCXCV claim(s) 31-32 (in part)drawn to a compound of formula III wherein X is trans and R1 and R2 are not sodium or potassium but another alkali metal or an alkali earth metal or a transition metal or one R is alternatively OH.

Group CCXCVI claim(s) 31-32 (in part) drawn to a compound of formula III wherein X is trans and R1 and R2 are a heteroarylene or a heterocyclyl or one R is alternatively OH.

Group CCXCVII claim(s) 31-32 (in part) drawn to a compound of formula III wherein X is trans and R1 and R2 are a nucleoside or nucleotide or one R is alternatively OH.

Group CCXCVIII claim(s) 31-32 (in part) drawn to a compound of formula III wherein X is trans and R1 and R2 are an alkaloid or one R is alternatively OH.

Group CCXCIX claim(s) 31-32 (in part) drawn to a compound of formula III wherein X is trans and R1 and R2 are an amino sugar or one R is alternatively OH.

Group CCC claim (s) 31-32 (in part) drawn to a compound of formula III wherein X is trans and R1 and R2 are aminonitrile or one R is alternatively OH.

Group CCCI claim (s) 31-32 (in part) drawn to a compound of formula III wherein X is trans and R1 and R2 are nitrogen containing antibiotic or one R is alternatively OH.

Groups CCCII- CCCVIII are the same as Groups CCXCV- CCCI except that the X is cis . Group CCCII also includes claim 36 as a preparation of the compound of claim 31 wherein the compound is a metal salt of the formula of claim 31.

Group CCCIX –CCCXXVIII claim (s) 34 (in part) are drawn to a pharmaceutical composition of compounds of Groups CCXCV-CCCVIII. These include claim 34 and for the cis isomer claim 35 is also included.

Group CCCXXIX claim (s) 37 and 38 (in part) drawn to a method of modulating tumor growth using a compound of formula VI where R1 and R2 are alkali metal or an alkali earth metal or a transition metal or one R is alternatively OH.

Group CCCXXX claim(s) 37 and 39 (in part) drawn to a method of modulating tumor group using a compound of formula VI where R1 and R2 are a heteroarylene or a heterocyclyl or one R is alternatively OH.

Group CCCXXXI claim(s) 37 (in part) drawn to a method of modulating tumor growth using a compound of formula VI where R1 and R2 are a nucleoside or nucleotide or one R is alternatively OH.

Group CCCXXXII claim(s) 37 (in part) drawn to a method of modulating tumor growth using a compound of formula VI where R1 and R2 are an alkaloid or one R is alternatively OH.

Group CCCXXXIII claim(s) 37(in part) drawn to a method of modulating tumor growth using a compound of formula VI where R1 and R2 are an amino sugar or one R is alternatively OH.

Group CCCXXXIV claim (s) 37(in part) drawn to a method of modulating tumor growth using a compound of formula VI where R1 and R2 are aminonitrile or one R is alternatively OH.

Group CCCXXXV claim (s) 37 (in part) drawn to a method of modulating tumor growth using a compound of formula VI where R1 and R2 are nitrogen containing antibiotic or one R is alternatively OH.

Group CCCXXXVI claim (s) 40 (in part) drawn to a method of modulating microbial growth using a compound of formula VI where R1 and R2 are alkali metal or an alkali earth metal or a transition metal or one R is alternatively OH.

Group CCCXXXVII claim(s) 40 (in part) drawn to a method of modulating microbial growth using a compound of formula VI where R1 and R2 are a heteroarylene or a heterocyclyl or one R is alternatively OH.

Group CCCXXXVIII claim(s) 40 (in part) drawn to a method of modulating microbial growth using a compound of formula VI where R1 and R2 are a nucleoside or nucleotide or one R is alternatively OH.

Group CCCXXXIX claim(s) 40 (in part) drawn to a method of modulating microbial growth using a compound of formula VI where R1 and R2 are an alkaloid or one R is alternatively OH.

Group CCCXL claim(s) 40 (in part) drawn to a method of modulating microbial growth using a compound of formula VI where R1 and R2 are an amino sugar or one R is alternatively OH.

Group CCCXLI claim (s) 40(in part) drawn to a method of modulating microbial growth using a compound of formula VI where R1 and R2 are aminonitrile or one R is alternatively OH.

Group CCCXLII claim (s) 40 (in part) drawn to a method of modulating microbial growth using a compound of formula VI where R1 and R2 are nitrogen containing antibiotic or one R is alternatively OH.

The inventions listed as Groups I- do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I- CXL are different processes for preparing different final products using different catalysts, solvents and reagents. The catalysts, the reagents and the reaction conditions are all different and there is no special technical feature which links all the groups. Nor do they meet the requirement of unity of invention since they are all process groups. Also some of the compounds being prepared are already known which also shows that even the some of the compounds being prepared do not add any special technical feature to the process (See CA:123:227731). Groups CXLI – CCXCIV are drawn to another set of processes which are different from the processes of Gorups I-CXL. There is an oxidation in this set of processes and the use of a 1 H tetrazole and a phosphine which is not part of the processes in Groups I-CXL and therefore the two sets of groups have no special technical feature which unites the processes. Within Groups CXLI-CCXCIV the processes are making different compounds using different reagents and solvents which lead to no special technical feature which unites the processes. The processes also do not fit under unity of invention which is required for there not to be a lack of unity. Groups CCXCV- CCCVIII are drawn to compounds which are not linked by a special technical feature to the processes of the groups above since some of the compounds are eliminated from the process (i.e. the scope of the compounds is smaller than the scope of the

processes being claimed in the above groups). There was one process in claim 36 that was the same scope as some of the compounds being claimed and that was added to the compounds being claimed in Group CCCII. The compounds have various nucleosides, nucleotides, heterocyclic moieties, amino sugars etc attached which give them different characteristics from each other and their structure are different and there is no special technical feature which unites the compound groups. There is also no unity of invention since all the groups are processes. There are pharmaceutical compositions which is different from the compounds since the compounds do not have to be pharmaceuticals and are not part of a composition These are groups CCCIX –CCCXXVIII . Also there is not unity of invention group which s drawn to compounds and compounds with pharmaceutical compositions. For there to be unity there must be a special technical feature and unity of invention.

Under unity of invention the following must be present as stated : "(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process."

Groups CCCXXIX – CCCXXXV are drawn to modulation of tumors which includes compounds not being claimed in the compound claims. For examples CA:123:227731 teaches comounds which are growth inhibiting cancer compounds that are phosphorus compounds of combretastatin and therefore there is no special technical feature which unites the method claims with the compounds Also the compound claims have precluded the compound found in CA:123:227731 but it is being claimed in the method claims so the scope is different of the pharmaceutical compositions and the methods. Also the other method claims are drawn to modulation of microbial growth. This method claim is has no unity of invention with the last group of method claims.

The groups meet the requirement of no special technical feature and/or no unity of invention and therefore are proper groups under Lack of Unity.

4. A telephone call was made to Susan Stone Rosenfield on February 8, 2004 to to discuss the lack of unity requirement, but did not result in an election being made.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Vollano whose telephone number is 703-305-4483. The examiner can normally be reached on Monday-Thursday 6:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Jean F. Vollano
Primary Examiner
Art Unit 1621

Jean F Vollano

February 9, 2004